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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,883	04/16/2001	Jaakko Rajaniemi	P277191	3470

7590 06/28/2004

Pillsbury Winthrop LLP  
1600 Tysons Boulevard  
McLean, VA 22102

EXAMINER

DAO, MINH D

ART UNIT	PAPER NUMBER
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2682

9

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/763,883

Applicant(s)

RAJANIEMI ET AL.

Examiner

MINH D DAO

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-30 is/are allowed.
- 6) ☒ Claim(s) 31,33,38,40-46 is/are rejected.
- 7) ☒ Claim(s) 32,34-37 and 39 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 41 recites the limitation "the first set of criteria" in line 1. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 31,33 are rejected under 35 U.S.C. 102(e) as being anticipated by Huusko (WO 98/37721).

Regarding claim 31, Huusko teaches a network controller for supporting a terminal in a telecommunications system including a core network (See Fig. 3, item CN) and an access network (See Fig. 3, item RAN), the network controller comprising: a reporting module (Page 11, lines 25-32) configured to report location information of the terminal to the core network; and a transforming module configured to transform the location information into transformed location information, wherein the transforming module transforms the location information into transformed location information prior to the reporting module reporting the location information of the terminal to the core network (Page 11, lines 33-36; Page 12, lines 1-30).

Regarding claim 33, Huusko teaches terminating a number of connection-oriented connections with the terminal and for reporting a real or correct location of the terminal to the core network in response to terminating a last connection-oriented connection with the terminal (page 5, lines 25-32).

Regarding claim 38, Huusko teaches receiving location information using the terminal, wherein the location information indicates a terminal location from which the terminal last received location information (page 5, lines 25-32).

Regarding claim 40, Huusko teaches the location information indicates at least one cell identifier, a routing area identifier or a location area identifier (page 11, lines 11-21).

Regarding claim 42, Huusko teaches that the serving and the drift network controllers are associated with a first and a second switching element, respectively, each of the first and second switching elements being configured to maintain subscription information related to the terminal; and the first switching element being configured to receive location information and to send location information to the second switching element without a separate request (Page 11, lines 33-36; Page 12, lines 1-30).

Regarding claim 43, Huusko teaches the location information comprises at least a Packet Data Protocol of the terminal, a Mobility Management context, a Packet Data Protocol of the terminal and a Mobility Management context (see fig. 2, item 2 (GSM/UMTS CN); page 11, lines 25-32).

Regarding claim 44, Huusko teaches the first and the second switching elements are a support node (see fig. 2, GSM/UMTS CN), a switching center (see fig. 2, TN) or a support node and a switching center.

Regarding claim 45, Huusko teaches the support node is a substantially serving General Packet Radio Service support node (see fig. 2, GSM/UMTS CN) and the switching center is a Mobile services Switching Center (see fig. 2, item TN).

Regarding claim 46, Huusko teaches a network controller of claim 31, wherein the terminal is a mobile station, the access network is a radio access network and the network controller is a radio network controller (see fig. 2, items MS, RAN and RNC).

### ***Allowable Subject Matter***

1. Claim 32 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 32, Huusko et al. (WO 98/37721) teaches all limitations in claim 31. However, Huusko fails to teach that the network controller of claim 31, wherein the core network is configured to determine the terminal location and the access network includes a drift network controller configured to maintain a connection with the terminal, wherein the network controller is configured to act, at least temporarily, as a serving network controller of the terminal in the access network, and to report the terminal location to the core network, and wherein the network controller is configured to receive location information from the drift network controller and to report the location

information to the core network for determining the terminal location. As specified in the claim.

2. Claims 1-30 are allowed.

The following is an examiner's statement of reasons for allowance:

Regarding claim 1, reference Huusko (WO 98/37721) fails to teach that the access network including a first network controller configured to at least temporarily act as a serving network controller of the terminal and to report a location of the terminal to the core network, and a second network controller configured to at least temporarily act as a drift network controller of the terminal and to maintain a connection with the terminal, the method comprising: transmitting location information of the terminal to the core network based on a first set of predetermined criteria, the location information being indicative of the terminal location; transmitting location information to the second network controller in response to the first set of predetermined criteria; transmitting the location information to the first network controller; reporting the location information to the core network; transforming the location information into transformed location information based on a second set of predetermined criteria; and transmitting the transformed information to the core network in response to the second set of predetermined criteria. As specified in the claim.

***Response to Arguments***

3. Applicant's arguments, see page 8, lines 12-20, filed on 04/13/04 with respect to claim 31 have been fully considered and are persuasive. The rejection of claim 31 has been withdrawn.

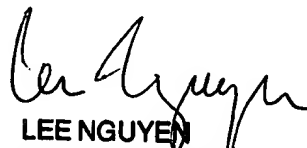
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH D DAO whose telephone number is 703-305-5589. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVIAN C CHIN can be reached on 703-308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MINH DAO *md*

  
LEE NGUYEN  
PRIMARY EXAMINER